



**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**In re Application of:**

Kirchholtes et al.

**Serial No.:** 09/787,215

**Filed:** May 17, 2001

**For:** HIGH PURITY COMPOSITION  
COMPRISING (7 ALPHA, 17 ALPHA)-17-  
HYDROXY-7-METHYL-19-NOR-17-  
PREGN-5(10)-EN-20-YN-3-ONE

**Confirmation No.:** 7592

**Examiner:** S. Jiang

**Group Art Unit:** 1617

**Attorney Docket No.:** 1963-5047US

**NOTICE OF EXPRESS MAILING**

Express Mail Mailing Label Number: EL994825879US

Date of Deposit with USPS: February 9, 2005

Person making Deposit: Allen C. Turner

**SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT**

Mail Stop RCE  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In compliance with the duty to disclose information material to patentability pursuant to 37 C.F.R. § 1.56, it is respectfully requested that this Supplemental Information Disclosure Statement be entered and the documents listed on attached Form PTO/SB/08 be considered by the Examiner and made of record. Copies of the listed documents are enclosed pursuant to 37 C.F.R. § 1.98(a).

Other Documents

Closed Record in the Petition of Arrow Generics Limited for Revocation of Claims in European Patent EP 1 121 375 B1 (June 9, 2004). Received from counsel on July 7, 2004.

Communication from Akzo Nobel with European Patent Office in response to Oppositions to EP 1 121 375 B1 (October 15, 2004).

Letter from Cavellier regarding Opposition against Columbian Patent Application 99065751 filed 15 October 1999 (June 2, 2004).

SCHOUTEN et al., Structure of the Triclinic Modification of 17beta-Hydroxy-19-nor-7 alpha-methyl-17alpha-pregn-5(10)-en-20-yn-3-one (ORG OD14), pp. 1754-56, International Union of Crystallography (1991).

Expert Report of Dr. Roger Newton in the Petition of Arrow Generics Limited for Revocation of Claims in European Patent EP 1 121 375 B1 (October 16, 2004).

V. Alexéev, Análise Quantitativa, pages 97-98 (Livraria Lopes da Silva, ed. Porto, pp. 97-98, 1983).

Levine et al. Hungarian Patent 160797 (January 12, 1971).

WATERS, An Introduction to Practical Organic Chemistry, pages 1-35 (London, UK 1934).

DEFENCES and COUNTERCLAIM, In the Court of Session, Intellectual Property Cause, Organon Labs, Ltd et al. v. Norton Healthcare. Received from counsel on January 10, 2005.

Presentation of Laboratorios Recalcine S.A. against Chilean Patent Application 2343-1999 (July 28, 2003). (English language translation).

Opposition by Gynopharm S.A. against Columbian Patent Application file number 99065751 (December 2, 2002). (English language translation).

Opposition by Asociacion de Laboratorios Farmaceuticos (ALAFAR) against application for Ecuadorian patent No. SP-99-3181 (June 2, 2000). (English language translation).

Serial No.: 09/787,215

This Supplemental Information Disclosure Statement is believed to be filed before the mailing date of the first Office Action on the merits subsequent to the filing of an RCE in the above-identified application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Allen C. Turner', with a long horizontal flourish extending to the right.

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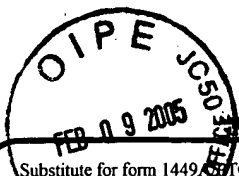
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Enclosures: Form PTO/SB/08

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PTO/SB/08B(10-03)

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**INFORMATION DISCLOSURE  
STATEMENT BY APPLICANT**

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Sheet 1 of 2

**Complete if Known**

Application Number	09/787,215
Filing Date	May 17, 2001
First Named Inventor	Kirchholtes et al.
Group Art Unit	1617
Examiner Name	S. Jiang
Attorney Docket Number	1963-50471JS

**NON PATENT LITERATURE DOCUMENTS**

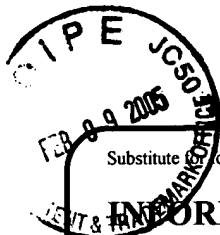
Examiner Initials *	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>2</sup>
		Closed Record in the Petition of Arrow Generics Limited for Revocation of Claims in European Patent EP 1 121 375 B1. (May 11, 2004)	
		Communication of proprietor Akzo Nobel with European Patent Office regarding Oppositions to EP 1 121 375 B1 (October 15, 2004).	
		Letter from Cavalier regarding Opposition against Columbian Patent Application 99065751 filed 15 October 1999 (June 2, 2004).	
		SCHOUTEN et al., Structure of the Triclinic Modification of 17beta-Hydroxy-19-nor-7 alpha-methyl-17alpha-pregn-5(10)-en-20-yn-3-one (ORG OD14), 1991, pp. 1754-56, International Union of Crystallography (1991).	
		Expert Report of Dr. Roger Newton in the Petition of Arrow Generics Limited for Revocation of Claims in European Patent EP 1 121 375 B1 (October 16, 2004).	
		V. Alexéev, Análise Quantitativa, pages 97-98 (Livraria Lopes da Silva, eds. Portugal).	X
		Levine et al. Hungarian Patent Application 160797 (October 30, 1973).	
		WATERS, An Introduction to Practical Organic Chemistry, pages 1-35 (London, UK 1934).	
		DEFENCES and COUNTERCLAIM, In the Court of Session, Intellectual Property Cause, Organon Labs, Ltd et al. v. Norton Healthcare (United Kingdom, 2004).	
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		Opposition by Gynopharm S.A. against Columbian Patent Application file number 99065751 (Columbia, December 2, 2002). (English language translation).	

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Sheet 2 of 2

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Group Art Unit	1617
Examiner Name	S. Jiang
Attorney Docket Number	1963-50471US

**NON PATENT LITERATURE DOCUMENTS**

Examiner Initials *	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>2</sup>
		Opposition against application for Ecuadorian patent No. SP-99-3181 (Ecuador 2000).	

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